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AF 2878

PATENT

Attorney Docket No.: A-67207/RMS/DCF (469420-56)

EXPRESS MAIL NUMBER: EV298967405US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: WALT, et al. Examiner: HANNAHER, C.
Group Art Unit: 2878

Serial No. 08/944,850
Filed: October 6, 1997
For: SELF ENCODING
FIBER OPTIC
SENSOR

APPELLANT'S REPLY BRIEF

Commissioner for Patents
Mail Stop Appeal Brief-Patents
Alexandria, VA 22313-1450

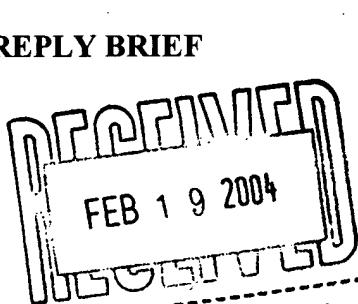
Sir:

This reply brief, filed in triplicate in connection with the above-captioned patent application, is in response to the comments by the Examiner set forth in the Examiner's Answer mailed December 2, 2003, providing a two-month deadline for response of February 2, 2004.

Grouping of Claims

In the Examiner's answer the Examiner disagreed with Appellant's statement in the brief that certain claims do not stand or fall together. Specifically the Examiner disagreed with the statement that claims 39 and 47 do not stand or fall together because claim 39 allegedly "anticipates or makes obvious claim 47 (which does not add any step to the recited method and accordingly merely restates what is inherent in clause (d) of claim 39)." Appellants respectfully traverse.

In contrast to the Examiner's suggestion, Appellants note that summing the first and second fluorescent signal as noted in clause (d) does not necessarily result in an increase in signal to noise ratio. Rather, in addition to the situation where the signal to noise ratio is increased, the claims also include the situation where discrete signals are measured from each



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sensor and summed. In some instances, for example, when a peak intensity signal is obtained for each sensor, the summed signal reflects the sum of the measured signal irrespective of the noise because the noise may not necessarily have been measured. For example, when a spectrum is measured it is possible to measure a single point of a spectrum, in which case noise may not necessarily be measured at all. Only the peak intensity of the signal may be measured. Support for this is found in the specification at p. 21, lines 12-14 where measurement of peak intensities are obtained from the sensors. In addition, p. 23, lines 12-17 provide support for the situation where discrete peak intensity measurements are obtained from an encoding dye and from an analyte reporting dye. Thus, it is not necessarily the case that the measurement in clause (d) requires measurement of both signal and noise because the clause also includes the situation where discrete measurements are obtained from a plurality of sensors and summed.

Accordingly, Appellants respectfully disagree with the Examiner's position regarding the grouping of claims. Appellants maintain that claims 39 and 47 do not stand or fall together.

Grounds of Rejection

Appellants maintain their position with respect to the Grounds of Rejection as set forth in the Appeal Brief mailed August 22, 2003.

Response to Arguments

Appellants maintain their position regarding the rejection under 35 U.S.C. 102 (e). Namely, Applicants maintain that Pinkel fails to disclose measuring the signal from individual sensors and summing the individual measured signal.

Appellants also maintain that the Examiner has failed to establish a *prima facie* case of obviousness. While the Examiner may have used the word "motivation" in the response to arguments section of the Final Office Action of June 20, 2002, Appellants maintain that the alleged motivation is inadequate as set forth in the Appeal Brief. Moreover, Appellants maintain that even assuming *arguendo* that there was motivation, the combination of references fails to teach each element of the claims.

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CONCLUSION

In light of the arguments set forth in Appellants' Appeal Brief and reiterated and clarified herein, Appellants' respectfully request the Board to reverse the final rejection of claims 39-48 and pass this application to issue.

The Commissioner is authorized to charge any fees, including extension fees, which may be required or credit any overpayment to Deposit Account No. 50-2319 (Our Order No. A-67207/RMS/DCF (469420-56).

Respectfully submitted,

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